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| 09/858,384 | 05/16/2001 | Timothy D. Allen | 47767-2 | 3415 |
| 24115 7590 06/16/2008 BUCKINGHAM, DOOLITTLE & BURROUGHS, LLP 3800 EMBASSY PARKWAY SUITE 300 AKRON, OH 44333-8332 | | | | |
| EXAMINER | | | | |
| NEWTON, JARED W | | | | |
| ART UNIT | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/858,384

Applicant(s)

ALLEN ET AL.

Examiner

JARED W. NEWTON

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-46 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 21-46 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

This final rejection is in reply to the remarks filed February 21, 2008, by which claims 1-20 were canceled, claims 21-25 were amended, and claims 27-46 were added.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the specification as originally filed does not appear to contain support for the following newly added limitations: "wherein the borrower is considering entering into a new relationship with a different mortgage institution" (claim 21, lines 5-6); "wherein the borrower is considering entering into a different relationship with a different mortgage servicing institution" (claim 27, lines 5-6; claim 34, lines 5-6; claim 41, lines 5-6); "notification . . . that the borrower is considering entering into a new relationship with the different mortgage servicing institution" (claim 1, lines 12-13); "notification . . . that the borrower is considering entering into the different relationship with the different mortgage servicing institution" (claim 27, lines 11-13); "notifying . . . that the borrower is considering entering into a

different mortgage servicing institution" (claim 34, lines 12-14; claim 41, lines 15-17). In the remarks supporting the amendments filed February 21, 2008, Applicant cites various portions of the specification in support of the newly added limitations (pages 11-13). The Examiner is unable to find support for the noted limitations in these citations or the remainder of the specification as originally filed. Applicant is respectfully requested to point to support for these limitations in the specification as originally filed, or, alternatively, withdraw the limitations altogether.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21, 22, 25-28, and 31-33 are rejected under 35 U.S.C. 102(e) as being anticipate by US Patent Application Publication No. 2001/0056397 to Kelly et al. (hereafter Kelly).

In regard to claims 21, 22, 25-28, and 31-33, *insomuch as understood in view of the 35 U.S.C. § 112 Rejections above*, Kelly discloses a system and method for tracking and modifying a mortgage rate, wherein said method includes the steps of:

(a) capturing customer indicia information input by a borrower (see [0027], [0032] – Kelly recites, “Using a Web browser or an e-mail program, [a user] requests a modification online”);

(b) identification of the borrower’s existing mortgage servicing institution through information input by said borrower and

(c) linking said borrower with said borrower’s existing mortgage servicing institution” (see id. – when a “user” of the “A.R.C. Loan service” as disclosed by Kelly submits information via a web browser, he is linked with the A.R.C. service to “request a modification online”); and,

(d) notification of the borrower’s existing mortgage servicing institution (see id. – the user’s “request for modification” notifies the A.R.C. service so that the service can determine if a modification is proper).

Kelly further discloses securing permission of said borrower prior to notification of said borrower’s mortgage servicing institution (see [0032]; inherent in customer initiated; system initiated requests permission).

Kelly further discloses displaying the customer retention program (see FIG. 7).

Kelly further discloses the A.R.C. service disclosed by Kelly includes a mortgage modification option (see Title).

Kelly further discloses changing terms on said borrower’s original mortgage, where said mortgage may be any product offered by said existing mortgage servicing institution (see [0021]).

In regard to claim 22, the limitations are deemed anticipated by the Kelly reference as set forth in the rejection of claim 2.

In regard to claim 25, the limitations are deemed anticipated by the Kelly reference as set forth

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 23, 24, 29, 30, and 34-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly as applied to claims above, in view of Applicant's Disclosure.

In regard to claims 3, 4, 8, 10, 15, 17, 23 and 24, Kelly discloses the system and method set forth above, including the steps of: capturing indicia input by a borrower; linking said borrower with his mortgage servicing institution; and notifying the institution.

Kelly does not explicitly set forth the steps of: identification of said borrower's mortgage servicing institution by a borrower's credit report and electronically parsing borrower's credit report to identify at least one of said borrower's mortgage servicing institutions. However, it was well known in the art at the time of the invention to obtain the identity of a borrower's mortgage servicing institution by means of a credit reports, as set forth in Applicant's disclosure (see US Patent Application Publication No.

2001/0044772, [0019] – [0022]). It was also well known at the time of the invention to electronically parse documents for specific information. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to modify the system of Kelly to include these well-known features so that an alternative determination of the mortgage service institution can be made if it is not initially known. For instance, if the system of Kelly wanted to identify if a person is a user of the A.R.C. service, and possibly eligible for mortgage modification, it would have been obvious to obtain the user information from a credit report.

Response to Arguments

In view of the claims as presently amended, the rejections under 35 USC 112, set forth in the office action mailed September 21, 2007 are hereby withdrawn.

Applicant's arguments with respect to the rejections under 35 USC §§ 102 and 103, filed February 21, 2008 have been fully considered but they are not persuasive.

As to Applicant's contention that "Kelly does not teach of the process of the present claims, wherein the borrower has an existing mortgage associated with an existing relationship with a mortgage servicing institution but is considering entering into a different relationship with a different mortgage servicing institution" (remarks, page 15) the Examiner maintains that Kelly meets the limitations as claimed as they are understood in view of the 35 USC 112 rejections set forth above. In particular, Kelly discloses a method for retaining mortgage customers by offering them a product having a rate that adjusts correspondingly with prevailing interest rates (see e.g. Kelly,

abstract). It is inherent within this teaching that the customers the system intends to retain are considering alternative mortgage products from new (that is, different) lenders. Furthermore, Kelly underscores this notion in the "Background of the invention," where he discusses the motivation for providing existing lenders with a system for retaining their customer, which customers are considering new mortgage products from different companies.

As to Applicant's contention that "Kelly also allows for a user-initiated modification of the mortgage product" (remarks, page 15), the Examiner fails to understand how this characterization of the Kelly reference would preclude anticipation of the instant invention, as claimed.

As to Applicant's contention that "it was not obvious [at the time of the invention] to combine the elements of identifying the servicing institution by the borrower's credit report and electronically parsing the credit report to identify the servicing institution with the Kelly invention" (remarks, page 16), the Examiner disagrees. As set forth in Applicant's own disclosure, there sometimes exists a "large gap between the identity of the mortgage servicing institution and the knowledge of the consumer" (specification, page 4, line 25). According to Applicant's disclosure, it was common at the time of the invention for mortgagees to not know the name of their lender. Therefore, regardless of whether the mortgagee intended to refinance or modify an existing mortgage product, there was a need for a system to identify the lender based on information other than the lender's name. This need would be prevalent if, for example, the system disclosed by

Kelly was implemented by a third party (i.e. non-lender), whose function is to track interest rates, and determine whether a particular customer is eligible for an adjustment.

With respect to Applicant's remaining contentions, the Examiner appreciates Applicant's explanation of the instant invention, and its alleged differences from the Kelly reference. However, the Examiner maintains that the Kelly reference as applied above meets the instant invention as presently claimed. Applicant contends that "The Allen invention allows the consumer to modify the terms of their existing mortgage" (remarks, page 18). Similarly, Kelly allows a customer to modify an existing mortgage product, wherein the mortgage product comprises the disclosed "Automatic Rate Cut mortgage." The Examiner does not dispute that the A.R.C. product is a new product, separate from a non-A.R.C. product. That is, the Examiner does not contend that a user of the system disclosed by Kelly modifies the terms of an existing mortgage so that the existing mortgage turns into an A.R.C. mortgage. Rather, the Examiner contends that once a customer obtains an A.R.C. mortgage, he can then have the terms--namely, the interest rate--of that product modified without taking on an entirely new product. This explanation comports with Applicant's characterization of the Kelly invention, where Applicant recites, "the Kelly mortgage product contractually requires the customer's current mortgage product to be modified" (remarks, page 14).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JARED W. NEWTON whose telephone number is (571)272-2952. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3693

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

JWN
June 8, 2008